

REMARKS

The Final Office Action, mailed October 30, 2007, considered claims 3-7 and 26-28. Claims 3-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Buelna* (U.S. patent No. 5,242,459), in view of *Andreas* (U.S. Patent No. 5,797,929). Claim 26 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Buelna* in view of *Andreas*, as applied to claim 3, and further in view of *Rosenbluth* (U.S. Patent No. 5,312,423). Claim 27 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Buelna* in view of *Andreas*, as applied to claim 3, and further in view of *Nobles* (U.S. Patent No. 6,733,509). Claim 28 was rejected under 35 U.S.C. 103(a) as being unpatentable over *Buelna* in view of *Andreas*, as applied to claim 3, and further in view of *Sancoff* (U.S. Pub. NO. 20020010480). By this amendment, claims 3-7 and 27-28 have been amended and claim 26 has been canceled. Claims 3-7 and 27-28 remain pending.

Applicants respectfully disagree with the combination of *Buelna* and *Andreas*, whether alone or in combination with *Rosenbluth*, *Nobles*, or *Sancoff*. In the rejection of claim 3, the Office Action, asserts that *Buelna* teaches "a shaft 16..., a suture retainer 12 ... [and] an opening 38 formed in the side of the shaft..." (Office Action, Page 2). It also indicates that "*Buelna* discloses the claimed device except for the shaft 16 having the groove formed in a side thereof, the groove being in communication with an opening formed in the said of the shaft" (Office Action, pages 2 and 3). *Andreas* was cited for allegedly teaching a groove formed in the side of shaft 16. It was indicated that "[it] would have been obvious . . . to provide the groove . . . since it is well known in the art to have a receiving opening and groove along a external surface of a suturing instrument in order to readily load sutures onto the device" (Office Action, Page 3).

The identified structure of *Andreas* is located at the distal portion of the knot pusher. The suggested modification to *Buelna* would appear to include the structure of *Andreas* at a location other than the distal portion of the knot pusher, i.e., upon shaft 12. *Andreas* neither teaches nor suggests this modification. Notwithstanding the above, there would be further no reason to combine the "groove" of *Andreas* with *Buelna* to modify shaft 16 because the suture of *Buelna* is "attached to a distal end of the body member 16" and is not loaded within the body member. When the *Buelna* device is reusable, it indicates that "[t]he free end of the suture 156 could be attached to the remainder of the loop applying assembly using a clip, collar, or similar attachable

device" (Col. 6, ll. 57-59). There is no mention of loading the suture free end within the body member. There is no reason to include a "groove" and "opening" in the identified shaft 16 because the suture does not appear to be loaded within the body member of *Buelna*. In fact, the attachment of the suture to the body member 16 is necessary for "the steps of tightening and severing the ligating loop . . . with a single motion of the hand" as described in *Buelna* (Col. 1, ll. 43-44). No loading of the suture free end beyond attachment "using a clip, collar, or similar attachable device" is taught or suggested. As such, Applicants respectfully disagree with the reasoning for combining the teaching of *Buelna* and *Andreas*.

As amended, claim 3 recites, in part,

"a suture retainer slidably disposed within the shaft and within the cutting member . . . the first lever operatively coupled to the suture retainer to move the suture retainer within the shaft and within the cutting member and the second lever operatively coupled to the cutting member to move the cutting member within the shaft and around the suture retainer to cut the suture."

The Office Action indicated that "*Buelna* discloses a cutting member 30 and the suture retainer 12 both slidably disposed within the shaft 16" *Id.* In reviewing *Buelna* it appears that "[a] cutting member 30 is coaxially received in a central lumen 13 (FIGS. 4-6) of the shaft 12. . . ." (Col. 4, ll. 65-66). There is no mention of the cutting member 30 being hollow or capable of receiving a structure within a hollow portion. *Buelna* discloses the "cutting member" being disposed within the shaft 12 and so the "axial passage 14 of the body member 16" (Col. 4, ln. 54) and not the reverse. *Buelna* also discloses a "shaft 112 [that] includes a port 118 on its side, where the port 118 has a sharpened distal end 120. A cutting member 130 is provided in the form of a rod having a blunt tip. . ." (Col. 6, ll. 36-39). Again, however, there is no teaching or suggestion to include a "suture retainer within the shaft and within the cutting member" as recited by independent claim 3.

Rosenbluth is cited in the Office Action for allegedly teaching "a suture retainer 23 slideable disposed within a cutting member 12 having cutting edge 86" (Office Action, Page 4). It is indicated that "[i]t would have been obvious . . . to provide the suture retainer within the cutting member, as taught by *Rosenbluth*, to *Buelna* and *Andreas* in order to better secure the suture within the device by keeping it internal to the cutting device." Applicants respectfully disagree.

The outer tube 12 of *Rosenbluth* "is fixed in a tubular sleeve 18 having an enlarged diameter proximal end 19 that abuts the distal end of a hollow, cylindrical handle member 20" (Col. 5, ll. 43-46). The suture and knot are "drawn up into the notch 17 at the distal end of the outer tube 12" to cut "the ends of the suture on either side of the knot 84" (Col. 8, ll. 14-15 and 24-25). There does not appear to be movement of the "outer shaft" within another shaft or within the inner tube which held the suture. As such, combining *Rosenbluth* with *Buelna* and *Andreas* again fails to teach or suggest the invention as claimed in independent claim 3, which recites, in part, "a suture retainer slidably disposed within the shaft and within the cutting member . . . the first lever operatively coupled to the suture retainer to move the suture retainer within the shaft and within the cutting member and the second lever operatively coupled to the cutting member to move the cutting member within the shaft and around the suture retainer to cut the suture." *Rosenbluth*, with *Buelna* and *Andreas* neither teach nor suggest "the suture retainer . . . within the shaft and within the cutting member" or movement of "the suture retainer within the shaft and within the cutting member and . . . [movement of] the cutting member within the shaft and around the suture retainer to cut the suture."

It is not clear to Applicants how to modify the teaching of *Buelna* in view of either *Andreas* or *Rosenbluth* to include the shaft 12 within the cutting member 30 of *Buelna*, allow the suture to pass through orifice 58 and side aperture 38, and perform "the steps of tightening and severing the ligating loop . . . with a single motion of the hand" as described in *Buelna* (Col. 1, ll. 43-44). Whether shaft 12 or body member 16 is considered as the suture retainer, *Buelna* neither teaches nor suggests the inclusion of the suture retainer within the cutting member and since *Rosenbluth* neither teaches nor suggests movement of the outer tube 12 having the cutting blades within a shaft that receives the cutting member and the suture retainer, Applicants respectfully submit that the invention as claimed in independent claim 3 is neither taught or suggested by *Buelna*, *Andreas* and/or *Rosenbluth*.

Nobles is cited in the Office Action for teaching "a suture cutter with a cutting member having a proximally facing edge 124", while *Sancoff* is cited in the Office Action for teaching "a first lever 22 and a second lever 24 each being movable with respect to a handle 14" (Office Action, Pages 4 and 5). It does not appear that either *Nobles* or *Sancoff* overcome the identified deficiencies of *Buelna*, *Andreas* and/or *Rosenbluth*.

Accordingly, because the allegedly obvious combination does not disclose each and every element of claim 3, Applicants respectfully submit that claim 3 and its associated dependent claims are in condition for allowance.

In view of the foregoing, Applicant respectfully submits that the other rejections to the claims are now moot and do not, therefore, need to be addressed individually at this time. It will be appreciated, however, that this should not be construed as Applicant acquiescing to any of the purported teachings or assertions made in the last action regarding the cited art or the pending application, including any official notice. Instead, Applicant reserves the right to challenge any of the purported teachings or assertions made in the last action at any appropriate time in the future, should the need arise. Furthermore, to the extent that the Examiner has relied on any Official Notice, explicitly or implicitly, Applicant specifically requests that the Examiner provide references supporting the teachings officially noticed, as well as the required motivation or suggestion to combine the relied upon notice with the other art of record.¹

In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at 801-533-9800.

Dated this 19th day of March, 2008.

Respectfully submitted,

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¹ Although the prior art status of the cited art is not being challenged at this time, Applicant reserves the right to challenge the prior art status of the cited art at any appropriate time, should it arise. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status of the cited art.